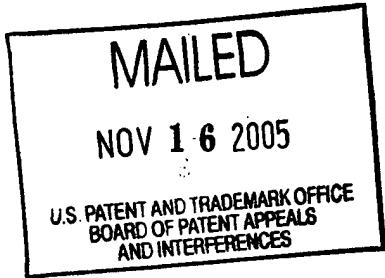


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte ANDREW MYERS
and SRINIVASA RAO KOLAPARTHI

Appeal No. 2005-2106
Application No. 10/041,571

HEARD: October 20, 2005

Before THOMAS, JERRY SMITH and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-23, which constitute all the claims pending in this application.

The disclosed invention pertains to a method and apparatus for annotating audible messages that are received by a subscriber of a unified communications service network.

Representative claim 1 is reproduced as follows:

1. A system for annotating audible messages that are received by a subscriber of a unified communications service network, the system comprising:

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a message presentation form that enables the subscriber to access audible messages, the message presentation form further comprising:

an audible message player that enables playback of audible messages;

a notes field that enables the subscriber to annotate the audible messages during playback of the audible messages; and

a message forwarder that enables forwarding of audible messages, wherein the annotations associated with the audible messages are forwarded at the option of the subscriber.

The examiner relies on the following references:

Wilcox et al. (Wilcox) 6,404,856 June 11, 2002
(filed Apr. 10, 1998)

Becker et al. (Becker) US 2002/0130904 Sep. 19, 2002
(effectively filed Mar. 19, 2001)

Claims 1-23 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Wilcox in view of Becker.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the

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rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in

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the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii) (2004)].

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The examiner has indicated how the claimed invention is deemed to be obvious over the collective teachings of Wilcox and Becker [answer, pages 3-6]. With respect to independent claims 1, 7, 12 and 18, appellants argue that Wilcox and Becker collectively fail to teach a notes field that enables the subscriber to annotate the audible messages during playback of the audible messages and a message forwarder that enables forwarding of audible messages and annotations at the option of the subscriber. Appellants also argue that the examiner has failed to establish a legally sufficient basis for combining the references. Finally, appellants argue that Becker is not analogous to the claimed invention [brief, pages 4-10].

The examiner responds that although Wilcox does not teach a message forwarder, a portion of Wilcox at least suggests a message forwarder. The examiner also notes that Wilcox was relied on to teach the annotation of an audible message during playback of the message in a notes field while Becker was relied on to teach that a message forwarder was well known. The examiner, otherwise, disagrees with each of appellants' arguments [answer, pages 6-10].

Appellants respond that the portion of Wilcox cited by the examiner fails to teach or suggest a message forwarder as

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claimed. Appellants also respond that Becker fails to teach or suggest the forwarding of audible messages and annotations.

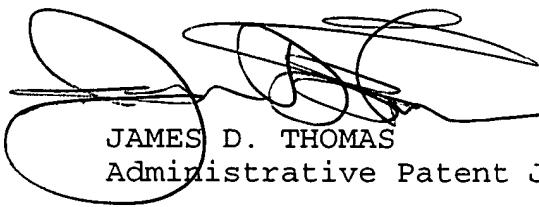
Finally, appellants argue that there is no motivation to modify the message forwarder of Wilcox with the teachings of Becker because there is no message forwarder in Wilcox [reply brief].

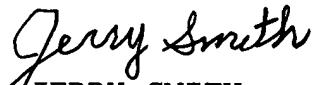
We will not sustain the examiner's rejection of independent claims 1, 7, 12 and 18 for essentially the reasons argued by appellants in the briefs. Most importantly, we agree with appellants that there is no teaching, suggestion or hint of a message forwarder in Wilcox. Therefore, the examiner's attempt to modify the message forwarder of Wilcox with the teachings of Becker is not based on any teachings within the applied references. We find the examiner's rejection to be unsupported by the evidence on this record, and the rejection can only be an improper attempt to reconstruct the claimed invention in hindsight. Since the rejection of each of the independent claims fails, the rejection of each of the dependent claims also fails.

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In summary, we have not sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-23 is reversed.

REVERSED


JAMES D. THOMAS)
Administrative Patent Judge)
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JERRY SMITH)
Administrative Patent Judge)
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BOARD OF PATENT
APPEALS
AND
INTERFERENCES
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MAHSHID D. SAADAT)
Administrative Patent Judge)
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